

## REMARKS

The Office Action mailed May 4, 2006 considered claims 1-31, 35 and 36. Claims 1-7, 11-18, 21-31 and 35-36, were rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, et al. (US 2002/0194307 A1) hereinafter *Anderson* in view of Oppenheimer, et al. (US 2003/0014477 A1) hereinafter *Oppenheimer* in view of Eldridge, et al. (US 6,487,189) hereinafter *Eldridge*. Claims 8, 9, 10, 19, 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Anderson* in view of *Oppenheimer* in view of *Eldridge* and further in view of LaRue, et al. (US 6,535,892 B1) hereinafter *LaRue*.<sup>1</sup>

By this paper claims 1, 11, 21 and 35 have been amended. Note that claims 23 and 30 have not been amended as applicants specifically traverse the Examiner's rejections which traversal was not addressed in the previous office action. Claims 1-31, 35 and 36 remain pending in the application of which claims 1, 11, 21, 23, 30 and 35 are the only independent claims of the application.

Claims 1 and 21 are method claims, which claim embodiments of applicants' invention from a client-side perspective, whereas claim 23 is directed to a similar method recited from the server-side perspective. Claims 11, 35, and 30 are computer program product claims which correspond to method claims 1, 21, and 23, respectively.

As presented herein for reconsideration, Applicants' claimed method and computer program product are adapted for use in a network environment that includes a client that is network connectable over a wireless network to a server so that the client may transmit document-inclusion operations that are intended to be carried out by the server, but wherein the wireless network may have limited throughput such that data transfer for document-inclusion operations may be unduly slow or costly. Applicants' claimed method and computer program product are designed to reduce those instances when the document-inclusion operation transmitted to the server actually requires transmission of a document that is required by the server to complete the requested operation, thereby reducing instances of unduly slow or costly data transmission when performing such document-inclusion operations over a wireless network.

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<sup>1</sup> Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

As an initial matter, applicants argued in the previous response that with respect to all of the independent claims 1, 11, 21, 23, 30, and 35, that Applicants respectfully traversed the Examiner's characterization of *Oppenheimer*. However, the Examiner did not respond to any of the Applicants' arguments related to the deficiencies of *Oppenheimer* with respect to the element directed to determining whether to send an identified document to the server. In particular, the Examiner stated in the previous office action, and reasserts in the present office action that “[a]lthough *Oppenheimer* does not explicitly state that the client determines whether to send the document to the server, rather merely states that the file is downloaded from the client one of ordinary skill in the art would find this feature obvious in order to conserve bandwidth on the user's network, thereby allowing more control over what the computer does and how it utilizes bandwidth (i.e. defer upload until a later time, when allowed by the user, etc.).” However, the Examiner is reminded that to sustain a *prima facia* obviousness rejection, “all the claim limitations must be taught or suggested by the prior art.” MPEP 2143.03. By the Examiners own admission (“although *Oppenheimer* does not explicitly state...”) *Oppenheimer* does not show the element of “whereupon, if it is determined by the client to send the document to the server, the server thereafter executes the document-inclusion instruction using the document sent by the client to the server.” As such, the Examiner has failed to show each and every element recited by the claims of the present application. If the Examiner is relying on Official Notice to supply the missing elements, Applicants respectfully requests that the Examiner provide documentary support showing the asserted elements of the Official Notice at the time of the invention and the requisite motivation for combining the asserted teachings with the asserted teachings of the cited art, as Applicant respectfully disagrees with the Examiner's assertions with regard to the asserted teachings and motivation for their combination to reject the claims. *See* MPEP § 2144.03(C). Moreover, Applicants remind the Examiner that it is generally against accepted examination guidelines to finally reject a claim while relying on Official Notice. MPEP § 2144.03(A) (“While ‘official notice’ may be relied on, these circumstance should be rare when an application is under final rejection”).

Additionally, Applicants point out the Examiners stated motivation is without logical support. In particular, the Examiner states that “one of ordinary skill in the art would find this feature obvious in order to conserve bandwidth on the user's network....” Applicants point out however that in the Examiner's described scenario, the deferral of transmitting does not conserve

bandwidth at all. The document is still sent using the same amount of bandwidth, just at a different time.

*Oppenheimer* illustrates a method of storing a file on a server. *Oppenheimer* states that “[i]f a copy of the file already exists on the server, the file need not be uploaded from the user’s local file system.” *Oppenheimer* at [0045]. However, “[i]f an identical file is not already stored on [the server], the file is suitably uploaded ....” This, however, clearly does not teach or even suggest that the client thereafter determines whether to send the document to the server, and particularly, *whereupon, if it is determined by the client to send the document to the server, the server thereafter executes the document-inclusion instruction using the document sent by the client to the server*. Rather, *Oppenheimer* simply allows files to be stored for backup purposes or for remote file access. See *Oppenheimer* at [0045]. As such, claims 1, 11, 21, 23, 30, and 35, which each recite a limitation similar to that described above, are believed to be patentable over *Anderson* and/or *Oppenheimer* alone or in combination.

With respect to the newly cited art, *Eldridge*, Applicants respectfully traverse the Examiner’s characterization of *Eldridge*. Nevertheless, to more fully illustrate the differences between the cited art and the claims of the present application, Applicants have made clarifying amendments to claims 1, 11, 21, and 35. In particular, these claims each recite: “displaying to a user at the client an indication that the document is attached to a message even when the document is not attached to the message and in response to user input received at the client instructing a document **stored at the client** to be attached to the message...” (emphasis added). In particular, Applicants would like to point out that this limitation specifically recites that a user attaches a document *which is stored at the client*. Not only does *Eldridge* not teach this limitation, *Eldridge* specifically teaches against this limitation. Specifically, *Eldridge* teaches that “[o]nly a reference to a document and not the contents of the document are actually stored on the mobile computing device.” Col. 7, lines 35-37. *Eldridge* further points out that by not including the document at the client, memory requirements can be minimized. Col. 7, lines 37-39.

In view of the foregoing, Applicants respectfully submit that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending

application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 3<sup>rd</sup> day of July, 2006.

Respectfully submitted,



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